

REMARKS/ARGUMENTS

I. Introduction

Claims 36-38, 51-55, 77-79 and 81-87 are pending and stand rejected. Applicants herewith cancel claim 87 and amend claim 77. With the entry of this amendment, claims 36-38, 51-55, 77-79 and 81-86 will be pending and active. Applicants assert that the entry of this amendment is proper in view of the fact that it removes all outstanding issues and places this case in condition for allowance.

Applicants thank Examiner Canella for the telephone interview on October 4, 2005.

II. The Examiner's Rejections

A. Rejections Under the Judicially Created Doctrine of Obviousness-Type Double Patenting

The Examiner has rejected claims 36-38 and 51-55 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 27-31 and 48-49 of U.S. Patent No. 6,821,726 ("the '726 patent"). Applicants submitted a terminal disclaimer overcoming such rejection with the response filed May 3, 2005. Applicants understand this terminal disclaimer has not been entered and that the Examiner also wants applicants to submit a Statement under Rule 3.37(b). Rather than comply with this request at the present time, Applicants would like to withdraw the terminal disclaimer previously submitted, and wish to challenge this rejection on the merits. Claims 36-38 and 51-55 of the present application are directed to method of simultaneously enriching tumor cells and depleting unwanted blood cells. The method of claims 27-31 and 48-49 of the '726 patent depend directly or indirectly from claim 1 and are directed to a method for the quantification of tumor cells in a body fluid. The

Examiner appears to have lodged this rejection because, in some embodiments, the respective methods both use the same vessel for separating cells. However, the steps in the respective methods are not the same. For instance, claim 27 and other dependent claims incorporate the amplification of mRNA step and the quantification step of claim 1. When read as a whole, the claims in the '726 patent do not suggest the methods of the present application. Accordingly, applicants respectfully request the Examiner to withdraw this obviousness type double patenting rejection.

B. Rejections Under 35 USC § 102(b)

The Examiner has maintained the rejection of claims 77-79 and 81 to 86 under 35 USC § 102(b) as being anticipated by Ayres *et al.* (U.S. Patent No. 3,945,928). The Examiner has alleged that Ayres *et al.* disclose a tubular container closed at both ends and divided into two chambers, with a flexible flap valve edge fixed to the barrier between the two chambers and the other portion of the edge free, wherein the flap, when subjected to a centrifugal force, flexes away from the valve seat, and upon cessation of the centrifugal force, returns to its normal position to seal the passageway between the two chambers (claim 1). The Examiner has further alleged that regarding claims 81 and 82, it is reasonable to conclude that the thickness of the flap would fall between 1-5 mm, given the scale of the drawing provided. Finally, the Examiner states that contrary to applicants' previous argument, the flap in Ayers effectively seals off the passage between the first and second chambers, thereby anticipating the rejected claims.

Applicants respectfully traverse this rejection. However, in further response, applicants herewith amend claim 77 to add that the vessel contains a cell separation medium having a density in the range from 1.055 to 1.065 g/ml. Support for this amendment can be found in the specification at page 5, lines 20-25. In view of this amendment, applicants respectfully request

Examiner Canella to withdraw this rejection.

C. Rejections Under 35 USC § 102(e)

The Examiner has maintained the rejection of claim 87 under 35 USC § 102(e) as being unpatentable over Ts'o *et al.* Applicants traverse this rejection. However, in further response, applicants have canceled claim 87. Consequently, this rejection is now moot.

III. Conclusion

In view of the above amendments and remarks, it is respectfully submitted that claims 36-48 and 51-86 are in condition for allowance. Applicants again thank Examiner Canella for the interview on October 4, 2005. Early notice of allowance is earnestly solicited. The Examiner is invited to telephone the undersigned at the number listed below if the Examiner believes such would be helpful in advancing the application to issue.

Respectfully submitted,

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